APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
09/038,158	03/11/98	WALLMAN	S	10392-46001

023838 TM02/1205	EXAMINER
KENYON & KENYON	AKERS, G
1500 K STREET, N.W., SUITE 700	ART UNIT PAPER NUMBER
WASHINGTON DC 20005	2164

DATE MAILED:

12/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

☒ Responsive to communication(s) filed on _Sep 18, 2000_

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____ _3_ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) _1-49_____ is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) _1-49_____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— *SEE OFFICE ACTION ON THE FOLLOWING PAGES* —

DETAILED ACTION

Response to Amendment

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action(Serial No: 09/038,158). The text of those sections of Title 35 US Code not otherwise provided in a prior Office action will be included in this action where appriopriate.

2. This action is responsive to the amendment filed 9/18/00.

3. No new claims were added. No claims were deleted. Claims 1-49 are pending, with claims 1,30,36,44,47 being the independent claims.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Independent claims 1, 36 are rejected under 35 USC 102(e) as being anticipated by Champion et al(US Pat. No: 5,126,936).

6. The rejections as stated in the First Action are maintained and repeated below for the independent claims.

7. As per claim 1, Champion discloses a system for enabling a plurality of users to create, manage,and trade a portfolio of assets/liabilities(col 3 lines 34-40) via a first plurality of communication links, one to each of the plurality of users(col 5 lines 25-28) over which each of the plurality of users transmits to the system trading data regarding trades to a plurality of assets/liabilities that each of the plurality of users desires to make(col 5 lines 40-53), with the system comprising a processor communicating with the plurality of users via the first plurality of communication links(col 5 lines 25-28)(col 5 lines 40-44), the processor receiving user identification information and trading data from each of the plurality of users(col 7 lines 32-37), the processor aggregating all buy orders and all sell orders for each asset/liability of the plurality of assets/liabilities included in the trading data from each of the plurality of users to obtain a single buy order and a single sell order for each asset/liability of the plurality of assets/liabilities represented in the trading data received from each of the plurality of users(col 5 lines 8-15)(col 5 lines 47-57), and the processor transmitting the single buy order and the single sell order to a third party for execution(col 5 lines 8-11), and a storage being coupled to the processor and storing the trading data from each of the plurality of users(col 5 lines 64-68)(col 6 lines 1-8).

8. As per claim 36, Champion discloses a method for creating and managing a portfolio of assets or liabilities by performing a plurality of transactions comprisingthe steps of: obtaining a plurality of user preferences for a plurality of portfolio characteristics of a user(col 5 lines 40-47)

and employing the plurality of a portfolio characteristics to describe and select a plurality of

assets or liabilities to be transacted in a plurality of transactions by a user(col 5 lines 40-52) and

aggregating the plurality of transactions of a single user with a plurality of transactions of a

plurality of others over an applicable characteristic ofthe plurality of assets or liabilities(col 5

lines 8-15)(col 5 lines 47-57).

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

10.   Independent claims 30, 44, and 47 are rejected under 35 USC 103(a) as unpatentable over

Champion(US Pat. No: 5,126,936).

11.   As per claim 30, Champion discloses a personal computer based system (col 5 lines 25-27)

for enabling a user to create. Manage and trade a portfolio of assets/liabilities and for interfacing

with a system for managing a plurality of such users via a communications link over which the

user transmits to the system trading data regarding trades of at least one asset/liability that the

user desires to make comprising: processing for prompting the user for user identification and

user preferences(col 7 lines 32-37) and process for enabling the user to interact with the

processor to select a plurality of assets/liabilities to create a user portfolio commensurate with the

percentage allocation of investment assets(col 5 lines 40-52) and a process for calculating risk

and a differential rewturn of the entire portfolio relative to a standard industry mesaurment to the

user(col 4 lines 11-13)(col 4 lines 46-51)(col 5 lines 3-7), and a portfolio editor process enabling

the user to adjust the user portfolio (col 8 lines 2-5) and a communication process

communicating user identification information along with trades of assets/liabilities to be

executed to create or modify a user's portfolio to ensure a user's actual portfolio matches a user's

desired portfolio(col 7 lines 32-37)(col 5 lines 40-52).

Chapman does not explicitly teach graphical user interface displaying information to the

user. Official notice is taken that graphical user interface is old and well known in the art of

computers. It is used in displaying analytical graphs of financial information on the Internet. It

would have been obvious to one of ordinary skill in the art at the time of the invention to use

graphical user interface for convenience. Also, Champion does not explicitly teach a user

program executing on a user's personal computer that performs prompting,transmitting, and

enabling of interaction. However, the user program is deemed inherent in Champion's system of

interactive data entry through a computer(col 5 lines 26-27). The process of receiving

information and transmitting them would be impossible without a user program that enables

Champion's personal computer to perform these tasks.

12. As per claim 44, Champion discloses an apparatus for enabling a plurality of users to make

investments in a portfolio of securities(col 3 lines 30-38) comprising a processor receiving data

from each of the plurality of users(col 5 lines 40-52) and a storage unit storing each user's

portfolio(col 5 lines 64-68)(col 6 lines 1-9). Champion does not explicitly teach processor

receiving data regarding amounts of money to be invested in each user's portfolio and accessing

an electronic payment system upon receiving instructions from a user to purchase securities to

obtain payment for the required purchase. Official notice is taken that receiving data regarding

amounts of money to be invested in a user's portfolio is old and well known in financial services

art. It would hasve been obvious to one skilled in the art at the time of the invention to receive

data regarding amounts of money to be invested in the user's portfolio because this would allow

appropriate amounts of money to be directed. Official notice is taken that accessing an electronic

payment system upon receiving instructions from a user to purchase securities to obtain payment

for the required purchase is old and well known in the art of financial services. It would have

been obvious to one of ordinary skill in the art at the time of the invention to have process of

accessing an electronic payment system upon receiving instructions from a user to purchase

securities to obtain payment for the required purchase because this would allow securities to

promptly settle.

13. As per claim 47 Champion discloses a method for enabling a plurality of users to make

investments in a portfolio of securities (col 3 lines 30-38) comprising receiving data from each of

a plurality of users(col 5 lines 40-52) and storing each user's portfolio(col 5 lines 64-68)(col 6

lines 1-9). Champion does not explicitly teach receiving data regarding amounts of money to be

invested in each user's portfolio and accessing an electronic payment system upon receiving

instructions from a user to purchase securities to obtain payment for the required

purchase.Official notice is taken that receiving data regarding amounts of money to be invested

in a portfolio is old and well known in financial services. It would have been obvious to one

skilled in the art at the time of the invention to receive data regarding amounts of money to be

invested in the portfolio for approipriate monetary allocation.Official notice is also taken that

accessing an electronic payment system upon receiving instructions from a user to purchase

securities to obtain payment for the required purchase is old and well known in financial services

art. It would have been obvious to one of ordinary skill in the art atthe time of the invention to

have process of accessing an electronic payment system upon receiving instructions from a user

to purchase securities to obtain payment for the required purchase because this would allow

securities to promptly settle.

14. All other claims in applicant's application are dependent upon these cited independent claims

1,30,36,44,47 which have been rejected. Accordingly, the dependent claims are thereby rejected

also.

Double Patenting

15.   Claims 1-49 of this application conflict with claims 1-17,20-32,45,47,49,51,53,55,64-

71,79-812 and 92-94 of Application No. 09/139,020. 37 CFR 1.78(b) provides that when two or

more applications filed by the same applicant contain conflicting claims, elimination of such

claims from all but one application is required in the absence of good and sufficient reason for

their retention during pendency in more than one application. Applicant is required to either

cancel the conflicting claims from all but one application or maintain a clear line of demarcation

between the applications, at this time. See MPEP § 822.

Response to Arguments

16.   Applicant's arguments filed 9/18/00 have been fully considered but they are not

persuasive.

Applicant states that independent Claim 1 recites a system for enabling a plurality of users to

manage and "trade a portfolio" of assets/liabilities.Champion discloses a system for enabling a

plurality of users to "create, manage and trade a portfolio of assets/liabilities(col 3 lines 34-40)

via a plurality of communications links, one to each ofthe plurality of users.."(col 5 lines 25-28).

Novelty is lacking in this independent claim.

Applicant also states that independent Claim 30 recites a personal computer basaed program

for executing on a user's personal computer, for enabling a user to create, manage and "trade a

portfolio" of assets/liabilities...Champion discloses a system communicating user identification

information along with "trades" of assets/liabilities to "be executed" to "create" ..a user's

portfolio to ensure the actual portfolio matches a desired one(col 7 lines 32-37)(col 5 lines 40-

52). Again, the trading of the portfolio is disclosed in Champion, and again, applicant's

independent claim lacks novelty.

Applicant furthermore states that independent Claim 36 recites a method for "creating and

managing a portfolio of assets or liabilities.." Champion discloses a system for creating and

managing a portfolio through the steps of first, obtaining a plurality of user preferences for a

plurality of portfolio characteristics ofa user(col 5 lines 40-47), then employing the plurality of

portfolio characteristics to describe and select a plurality of assets or liabilities to "be

transacted..by a user"(col 5 lines 40-52) and lastly, aggregating the plurality of transactions of a

single user with a plurality of transactions of a plurality of others over an applicable characteristic

ofthe plurality of assets/libilities(col 5 lines 8-15)(col 5 lines 47-57). As a result of the foregoing,

applicant's independent claim 36 also lacks novelty.

Next, applicant argues that independent Claim 44 recites an "apparatus for enabling a plurality

of users to make periodic investments in a portfolio". Champion discloses an apparatus for

enabling a plurality of users to make investments in a portfolio of securities(col 3 lines 30-38).

Consequently applicant's independent claim 44 lacks novelty.

Finally, applicant cites independent Claim 47 recites a "method for enabling a plurality of users

to make periodic investments in a portfolio of securities.." Again, Champion discloses a method

for enabling a plurality of users to make investments in a portfolio of securities(col 3 lines 30-

38). Applicant's independent claim 47 also lacks novelty.

Consequently all of Applicant's independent claims having been rejected, his dependent claims

are also rejected as a result of their dependency. Applicant has failed to demonstrate novelty in

his claimed invention.

Conclusion

17.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any questions regarding this communication should be directed to the examiner, Dr. Geoffrey

Akers, P.E. who can be reached at (703)-306-5844 between the hours of 6:30 AM and 5:00 PM

Monday through Friday. If attempts to contact the examiner are unsuccessful, the examiner's

supervisor, Mr. Vincent Millin may be telephoned at (703)-308-1065.

GRA

December 1, 2000

VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100